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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,787	12/26/2001	Robert H. China	679.0038USU	7192

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Charles N.J. Ruggiero, Esq.
Ohlandt, Greeley, Ruggerio & Perle, L.L.P.
10th Floor
One Landmark Square
Stamford, CT 06901-2682

EXAMINER

TRAVERS, RUSSELL S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,787

Applicant(s)

CHINA ET AL.

Examiner

Russell Travers, J.D., Ph.D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 26-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

The election filed July 18, 2003 has been received and entered into the file.

Claims 1-39 are presented for examination.

Applicant's election with traverse of Group I, claims 1-25 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that Applicants did not approve of the restriction. This is not found persuasive because to successfully traverse a restriction, substantive reasons relating to the actual claimed subject matter must be set forth. .

The requirement is still deemed proper and is therefore made FINAL.

The amendment filed March 11, 2004 has been received and entered into the file.

Applicant's arguments filed March 11, 2004 have been fully considered but they are not deemed to be persuasive

Newly submitted claims 29-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new composition of matter is directed to pressed powder composition requiring a liquid binder phase, not recited the composition originally claimed, and seen as a distinct inventive entity.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 26-28 reading on non-elected subject matter are withdrawn from consideration.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Information describing the JISA hardness index are not set forth in the specification in a manner enabling the skilled artisan practice the invention as claimed. Examiner notes information essential to practicing the claimed invention can be incorporated only by reference to issued United States Patents. Essential material incorporated by reference to non-United States Patents fails to meet those criteria established under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-25 are rejected under 35 U.S.C. § 103 as being unpatentable over Dobkowski et al and Anderson, in view of Yoshimasa et al.

Dobkowski et al (672) and Anderson (064) teach the claimed silicone elastomer (see (672) column 2,(064) Column 4), colorant ((064) column 6, paragraph 38))and nylon fillers (see (064), paragraph 27) as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. These ingredients are taught as useful for formulating cosmetic formulations and various skin coverings,

Claims 1-25, and the primary references, differ as to:

- 1) the concomitant employment of these medicaments, and
- 2) specific hardness of the formulations.

It is generally considered prima facie obvious to combine two, or more, compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional cosmetic agents. It would follow that the recited claims define prima facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Claims 1-12, 19 and 21 specifically require a composition of matter possessing a defined hardness. Yoshimasa et al employs those compounds herein recited for the cosmetic use herein claimed, at a hardness encompassed by the instant claims. Absent specific compression steps, not recited in the instant composition claims, the skilled artisan would expect on normal compression, the prior art compounds to provide the hardness herein recited, absent information to the contrary. A compound's properties are integral to those compounds. Thus, the skilled artisan would employ the prior art compounds in a cosmetic composition, and enjoy a reasonable expectation of success in formulating a composition possessing those properties herein recited, absent information to the contrary. The skilled artisan would have seen conventional cosmetic compositions, and the manufacture of these compositions by conventional means as residing in the skilled artisan purview.

RESPONSE TO ARGUMENTS

Examiner believes the hardness measures employed in the instant invention are employed routinely, yet this knowledge fails to meet the standard required for issuance of United States Patents. A hardness standard critical to the instant invention must be enabled by disclosed methods, or reference to an issued U.S. Patent. Absent such disclosures, the system employed simply fails to meet the required criteria. Examiner's burden has been met: the JISA standard method to determine the hardness standard is not disclosed herein, or set forth by reference to an issued U.S. Patent.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes Yoshimasa et al teach a pressed powder formulation at a hardness similar to that hardness herein claimed. Cosmetic formulations are normally made into pressed powder formulations, with this form being the simple selection from among obvious alternative forms.

The declaration filed March 11, 2004 has been considered, but is unconvincing. Applicants aver unexpected benefits residing in the claimed subject matter, yet fail to set forth evidence substantiating this belief. Evidence as to unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). The data provided by Applicants is not reasonably commensurate in scope with the instant claims, and fails to compare these

results to the closest prior art. Comparison to the closest prior art is the minimum requirement for illustration unexpected benefits: a minimum requirement to overcome an obviousness rejection.

Absent claims commensurate with the showing of unexpected benefits, or a showing reasonably commensurate with the instant claims, such claims remain properly rejected under 35 USC 103.

It is well known by the skilled artisan that carriers and excipients are employed to enhance the activity of active ingredients. Thus, the skilled artisan would expect conventional excipients and carriers to be useful concomitantly, absent information to the contrary. The instant carriers and excipients are not employed concomitantly in the prior art, thus only obviate their concomitant use.

Applicant's attention is drawn to In re Graf, 145 USPQ 197 (CCPA 1965) and In re Finsterwalder, 168 USPQ 530 (CCPA 1971) where the court ruled that when a substance is unpatentable under 35 USC 103, it is immaterial that applicant may have disclosed an obvious or unobvious further purpose or advantage for the substance.

Examiner would favorably consider claims directed to those cosmetic compositions providing unexpected benefits, as averred herein.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS

SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE
EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING

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DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Travers, J.D., Ph.D whose telephone number is 703-308-4603. The examiner can normally be reached on Monday to Thursday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-272-0631.

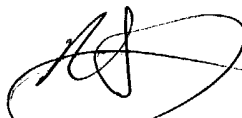
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'RT', enclosed within a large, loopy circular flourish.

Russell Travers J.D., Ph.D.
Primary Examiner
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